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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/926,185	04/01/2002	Steve Worthington	P67146US0	2831

136 7590 05/18/2005
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EXAMINER

VO, TED T

ART UNIT PAPER NUMBER

2192

DATE MAILED: 05/18/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/926,185

Applicant(s)

WORTHINGTON ET AL

Examiner

Ted T. Vo

Art Unit

2192

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 December 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 2 is/are pending in the application.
- 4a) Of the above claim(s) 2 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 2 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 12/20/04.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. This action is in response to the amendment filed on 12/20/2004 responsive to the Office action dated, 09/20/04.

Within this detailed action,

- Claim 2 is withdrawn because of restriction/election requirement.
- Claims 1-2 are pending in this application.

Response to Arguments

2. Applicants' arguments filed within the amendment on 12/20/04 have fully considered but are moot in view of the new ground(s) of rejection presenting in this Action.

Furthermore, the Applicants' arguments result a restriction/election requirement to Claim 2 that is identified as the distinct invention from the claimed invention of Claim 1. Accordingly, this action is non-final.

Election/Restrictions

3. The argument in Claim 2 shows it is a claimed invention that is independent or distinct from the original Claimed invention of Claim 1. The restriction/election is required for the following reasons:

The original Claim 1, a Document Assembly System, and the independent claim 2, an authorize software, are distinct.

-The originally claim 1, which claims a document assembly to allow a user with web connectivity and a browser to invoke assembly document, classified in class 717, subclass 123.

-The independent claim 2 directs to software for creative of interactive webpage, classified in class 717, subclass 115.

Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have **different modes of operation, different functions, or different effects** (MPEP § 806.04, MPEP § 808.01).

Furthermore, this case, the software of Claim 2 and the system of Claim 1 are not operated in the **same mode and same functions**. Their operations and performances are independent as seen in the Applicants' arguments. The means and steps of these claimed inventions (independent Claim 1 and independent Claim 2) are in separate status in the art, different classification, and divergent fields of search.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

Since the claim 1 are entered and pending in this application, and only one invention is required for further consideration, it is respectfully requested for a cancellation of Claim 2, and suggested that a divisional application would be filed in regard to the independent Claim 2.

Since Claim 1 has received an action on the merits as for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claim 2 is withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

A person shall be entitled to a patent unless –

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ahonen et al., "Assembling Documents from Digital Libraries", 1997.

Given the broadest reasonable interpretation of followed claims in light of the specification.

As per Claim 1: Ahonen discloses, *"A document assembly system resident on a web server which allows a user with web connectivity and a browser to invoke said system and interactively assemble a document at the web server comprising:*

a stored library of packets of text each relating to a different document and each document packet containing blocks of text that will meet a variety of possible contingencies for a document of that type (See page 3, Section 2.1: Structure of the Documents: referring to 'digital library'. See page 7, section 3.1: referring to 'Document fragments', or 'document collections'),

means which dynamically create web pages applicable to a document which present document determining queries to the user's browser and capture decisions made by said user in response, together with unique user input data relevant only to the particular document being assembled (See Fig.1, 'browsing', 'tailored document', and see page 3, section 2: System for Tailoring Textbooks via WWW),

means which selects from said library blocks of language based on said user decisions, (See page 4, section 2.2, indentation 1, 'The client fills in an HTML form and submits it.') a database which

Art Unit: 2192

stores said user data, software that assembles said blocks of language and populates the assembled document with said user data (See page 5, Fig. 3, 'WWW server', 'Technical editor' (database), see page 2, whole Fig. 1, 'Assembly process' (assembled document)),

means for delivering the assembled document to said user".

Ahonen discloses assembling the documents. The delivery shown the Fig. 3 is in the printing manner.

Ahonen does not explicitly disclose delivering the assembled documents to the user in which the documents are part of the document assembly on a web server. However, Ahonen suggests that the documents include SGML/HTML format (page 9), which is the Internet browser readable format.

Official notice is taken that delivering documents to a user via web server is well known in the art. Therefore, it would be obvious to a person of ordinary skill in the art at the time of the invention was made to include *assembling the documents in the web readable format*. Thus it could be part of web server delivering, and could deliver to a user by taking advantage of network which requires a standard web language HTML/XML format as transmitted data, the language is designed for Web Browser, and thus it could allow the documents to be transmitted over a network to a user.

Conclusion

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ted T. Vo whose telephone number is (571) 272-3706. The examiner can normally be reached on 8:00AM to 5:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tuan Q. Dam can be reached on (571) 272-3694. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Any inquiry of a general nature or relating to the status of this application should be directed to the TC 2100 Group receptionist: 571-272-2100. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for

Art Unit: 2192

published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read 'Ted Vo', with a stylized flourish at the end.

Ted T. Vo
Patent Examiner
Art Unit 2192
May 12, 2005